

### **REMARKS**

Claims 1-14 are pending in the application. No amendments to the claims have been made by this Reply. Accordingly, Claims 1-14 are at issue.

#### **Remarks Concerning Rejections Under 35 U.S.C. § 103**

On page 6 of the April 6, 2005 Office Action, the Examiner rejected Claims 1-3, 5-7, 8-10 and 12-14 as being unpatentable over U.S. Patent Application Publication No. 2002/0029086 ("Ogushi") in view of U.S. Patent No. 6,230,199 to Revashetti et al. ("Revashetti"). In light of the remarks made herein, Applicant respectfully traverses this rejection.

The present invention is directed to a system for remote configuration monitoring of an industrial control system. The system has two components. The first component is a device identifier, which determines the components of an automation or control device in the industrial system *by periodically querying* the device to obtain information from the device. The device identifier has a database that contains component identifications for the device. The second element of the system is a device configuration manager, which compares the installed device components with available device components, and provides an offer to upgrade installed components. There are two independent claims in the present application, Claims 1 and 8, both of which are drawn to this system. Claims 1 and 8 differ in that in Claim 8, the device identifier determines the components of a plurality of automation or control devices in the industrial system, whereas Claim 1 is directed to a system for identifying the components of a single device.

Ogushi is directed to a remote maintenance system, where a host computer in a factory detects trouble in industrial equipment, and notifies a vendor of that trouble. The Examiner has conceded that Ogushi "does not teach a device identifier periodically querying device(s) to obtain form the device information identifying at least some of its component hardware, software, and firmware" (page 3, April 6, 2005 Office Action).

Revashetti does not disclose that limitation, either. Revashetti is directed to a system and method for actively marketing products and services. Revashetti describes a scan routine that analyzes software components on a client computer, and presents "marketing opportunities" based on the scan. But like Ogushi, Revashetti is directed to a *one time scan*. There is no disclosure in either of those references of periodic querying, periodic scanning, or any other periodic analysis of the client machine. Instead, Revashetti is directed to a single, one-time analysis of the client computer.

The portion of Revashetti cited by the Examiner, col. 6, lines 55-67, discloses only a single scan of the client computer. The word "periodic" does not appear in that citation (or anywhere else in the Revashetti description). Applicant respectfully submits that Revashetti is simply not directed to any type of periodic or intermittent scan, and instead discloses only a single, stand-alone, one-time, non-periodic analysis. The present invention is directed to a *periodic* querying of the client machine, and neither Ogushi nor Revashetti discloses that limitation.

Neither Ogushi nor Revashetti discloses a *periodic* querying of an automation or control device. That limitation is found in both of the independent claims of the application, Claims 1 and 8. Applicant respectfully submits that Claims 1 and 8 are therefore patentable over Ogushi and Revashetti, and requests that those claims be allowed to issue. Because dependent Claims 2-7 and 9-15 include all the limitations of Claims 1 and 8, respectively, those claims are patentable for the same reason.

With respect to the Examiner's rejection of Claims 4 and 11 (page 5, April 6, 2005 Office Action), Applicant respectfully submits that U.S. Patent No. 6,122,639 to Babu ("Babu") also fails to disclose a periodic querying of an automation device. Because none of cited references disclose that limitation, Applicant respectfully submits that Claims 4 and 11 are patentable as well.

Applicant further respectfully submits that the combination of Ogushi and Revashetti is improper because there is no motivation or incentive in the prior art to combine those references in the manner suggested by the Examiner. See *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where a teaching, suggestion or

motivation to do so is found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combinations and a reasonable expectation of success of that combination must both be found in the prior art, not in the applicant's disclosure, *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness, MPEP § 2142. In the present case, the Examiner has failed to meet that burden. Instead, the Examiner has simply concluded one skilled in the art would make the suggested modification. That is insufficient.

The Examiner has opined that there is an incentive to combine the Ogushi and Revashetti references because "it would provide for the purpose of marketing software, hardware, and related products" (page 4, April 6, 2005 Office Action). However, that conclusion is simply a hindsight determination, which is an improper foundation upon which to combine references.

Hindsight combination of references, using the present invention as a roadmap, is improper. It is well recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed invention obvious, *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Moreover, Revashetti explicitly teaches away from the Examiner's proposed suggestion to combine that reference with Ogushi. Revashetti discloses that the software for performing the analysis of the client computer is downloaded to the client computer itself before execution (col. 6, lines 34-42). Revashetti goes on to say that *not* downloading the software to the client machine (i.e., running the software from a server) is disadvantageous (col. 7, lines 30-35):

These items could remain on the service provider computer system 206 and run across the network 204 against the client computer 208. However downloading these items to the client computer 208 reduces the bandwidth requirements of executing programs across the network over a communications device, such as a modem.

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Ogushi, however, is explicit that the software is run from a server (e.g., ¶¶ 23, 24, 31). Revashetti therefore teaches away from the combination of its software with the Ogushi system. Moreover, the Revashetti and Ogushi systems are in entirely different fields. Ogushi is in the field of remotely monitoring factory equipment for signs of failure, whereas Revashetti is in the field of locally analyzing software to determine whether an upgrade is needed. Applicant respectfully submits that the purposes and fields of Ogushi and Revashetti are simply too far removed from each other for the combination of those references to have been obvious to one of ordinary skill in the art. For all of the foregoing reasons, Applicant respectfully submits that the combination of the Ogushi and Revashetti references is improper.

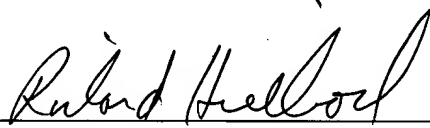
### CONCLUSION

In light of the remarks made herein, Applicant respectfully submits that Claims 1-14 are in condition for allowance. Applicant respectfully requests that the Examiner withdraw the rejections and allow the claims to issue. If it may be of assistance to contact the undersigned Attorney regarding the present invention, the Examiner is invited to do so. The Commissioner is hereby authorized to charge Deposit Account No. 23-0280 in connection with any fees associated herewith.

Respectfully submitted,

Dated: June 30, 2005

By: \_\_\_\_\_

  
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**CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service, with first class postage prepaid, in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 30, 2005

  
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